

## **REMARKS/ARGUMENTS**

This Amendment is submitted in response to the Office action dated April 11, 2007. Claims 1-27 are currently pending in this application. By this Amendment, Claims 1-5, 7, 8, 11, 12, 14, 17, 18 and 20-22 are amended. Favorable reconsideration of the application is respectfully requested.

### **1. Rejection of Claims 1, 2, 4, 7-11, 20-23, 26 and 27 under 35 U.S.C. 102(b)**

Claims 1, 2, 4, 7-11, 20-23, 26 and 27 stand rejected under 35 U.S.C. 102(b) over Erkfritz (U.S. Patent No. 3,701,187, hereinafter “Erkfritz”). The rejection is respectfully traversed.

By this Amendment, independent Claims 1 and 8 are amended to include the feature of a toolholder comprising an insert-receiving cartridge having a pocket and a shank removably received in a bore of a support member.

By contrast, Erkfritz discloses a plurality of cartridges 75, 76 and 77 for supporting inserts 45, 46 and 47, respectively. Each cartridge comprises a block-like member of rectangular cross-section and is formed with a generally flat platform 80 that extends tangentially of the disk 40. A key 81 formed on the trailing wall of the cartridge fits into a keyway 83 cut in the rear wall of the recess 79 to locate the cartridge accurately in the recess while a screw 84 anchors the cartridge securely in place. *See col. 5, lines 36-58; Figs. 2, 3 and 8.*

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See MPEP §2131.* Contrary to the Office action that all of the elements of Claim 1 is disclosed in Erkfritz, at least the feature of an insert-receiving cartridge having a pocket and a shank removably received in the bore of the support member, is not disclosed, taught or suggested in Satran, so the rejection is unsupported by the art and should be withdrawn.

For at least this reason, independent Claims 1 and 8 are allowable over the applied art. Claims 2, 4, 7 and 26, which depend from Claim 1, and Claims 9-11, which depend from

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Claim 8, are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

By this Amendment, independent Claim 20 is amended to include the feature of a toolholder capable of performing a static turning machining operation comprising a body portion including a plurality of cutting inserts, wherein the toolholder moves between fixed static positions by rotation and translation at least in an axis perpendicular to a normal cutting plane (Y-axis) of the machine tool to individually present each cutting insert to the rotating workpiece during the static turning machining operation.

Erkfritz teaches a slotting cutter body design that can accept insert carriers using two types of inserts to produce slots in a workpiece during a rotary cutting machining operation. In other words, Erkfritz teaches a tool that rotates, not a static turning tool of the claimed invention because mill/turn machines with "Y" axis travel did not exist at the time of the Erkfritz patent.

For at least this reason, Claim 20 is allowable over the applied art. Claims 21-23 and 27, which depend from Claim 20, are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

## 2. **Rejection of Claims 3, 5, 6, 12, 13-19, 24 and 25 under 35 U.S.C. 103(a)**

Claims 3, 5, 6, 12, 13-19, 24 and 25 stand rejected under 35 U.S.C. 103(a) over Erkfritz. The rejection is respectfully traversed.

Claims 3, 5 and 6 depend from Claim 1. Claims 12 and 13-19 depend from Claim 8. Claims 24 and 25 depend from Claim 20.

According to MPEP §2143, to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the applied reference must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

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For the same reason as stated in Paragraph 1 above, Erkfritz does not teach all the claim limitations as recited in Claims 1, 8 and 20, and the Office action fails to establish a *prima facie* case of obviousness. *See MPEP §2143.*

For at least this reason, Claims 3, 5 and 6, which depend from Claim 1, Claims 12 and 13-19, which depend from Claim 8, and Claims 24 and 25, which depend from Claim 20, are allowable over the applied art. Withdrawal of the rejection is respectfully requested.

**3. Conclusion**

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable consideration and prompt allowance of the application is earnestly solicited.

Should Examiner Fridie Jr. believe anything further would be desirable in order to place the application in better condition for allowance; the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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